

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

EBRY0001

I hereby certify this correspondence is being electronically submitted to the USPTO:

on April 24, 2012

Signature

Typed or printed name Christine Ortt

Application Number

09/498,944

Filed

02-04-2000

First Named Inventor

Christopher WARNOCK

Art Unit

3621

Examiner

Le, Nancy Loan T.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 30176☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Michael A. Glenn

Typed or printed name

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Telephone number

April 24, 2012

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Christopher WARNOCK
Application Number: 09/498,944
Filing Date: February 4, 2000
Group Art Unit: 3621
Confirmation Number: 9493
Examiner Nam: Le, Nancy Loan T
Title of Invention: Method and apparatus for improved information
transactions
Attorney Docket Number: EBRY0001

April 24, 2012

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF

Applicants submit this Pre-Appeal Brief along with a Notice of Appeal in connection with the above-identified patent application. Applicants do not believe the filing of this brief will incur additional fees. However, the Commissioner is authorized to charge any fees that may be due and to credit any overpayments to Deposit Account 07-1445 (Order No. EBRY0001). Applicants consider this document to be filed in a timely manner.

This application has now been pending for over 12 years and Applicant has repeatedly addressed and overcome various rejections during this time. Most recently, agreement was reached with the Examiner during an interview, held on June 30, 2011, regarding the allowability of the pending claims within the application. Now comes the Examiner with yet another rejection under 35 USC § 103, this time citing Berstis (USPN 6,282,653) in further view of Satoh (USPN 6,327,600) against Applicant's claims as set forth in Applicant's response of July

13, 2001.

Berstis discloses the use of a source and a target with a secure link therebetween (see, for example, col. 7, lines 30-61 and Figures 2-4). A payment scheme is discussed in connection with Figure 5. In no place, however, does Berstis discuss Applicant's claimed "security server to prevent the user from performing a standard operation on said version, said standard operation consisting of any of copying, printing, or saving." Berstis (Figure 4) discloses a management server that establishes a royalty account for content providers. The royalty account receives information on the use of content to keep a tally of royalties due to the copyright owner (col. 8, lines 8-35), but the management server does not function to prevent the user from performing a standard operation on the content in question, as does Applicant's claimed security server. In Berstis, all such function is controlled by the source via the secure link to the target. As such, Berstis is irrelevant to the invention as claimed.

The Examiner also states:

"10. Berstis does not expressly disclose the following aspects:

11. calculating with said document server a charge to permit the user to perform a requested standard operation on a user-selected portion of said specific document on a second cost basis; and

12. delivering to said user, via said document server, a second version of the actual contents of said specific document residing at said document server comprising said user-selected portion of said specific document, wherein a user requested standard operation is completed, in coordination with said document server, upon payment of the calculated charge."

The Examiner relies upon Satoh to address these acknowledged deficiencies of Berstis.

It is important to note that Applicant claims two or more versions of the actual contents of a document residing at the document server, the second version comprising a user-selected portion of the document for which the user has requested and paid for a standard operation. Thus, in the claimed invention a separate version exists for each set of rights sought and that separate version is only transferred from the document server under control of the security server.

Prior art approaches transfer a single version of the document to a destination and then release rights in that version as paid for. Satoh discloses this prior art approach. Thus, Satoh transfers a document from the document storage unit to the document production unit. Once the document is at the document production unit, the user may request rights which may then be released to the user by the copyright management information check unit (Figure 1; col. 4, lines 33-44). Satoh does not provide first and second versions of a document that are released to a destination from a document source under supervision of a security server. Rather, Satoh provides a document to a document production unit from a document storage unit. The rights in this document at the document production can then be determined. That is, there is only a single document in Satoh and its use is controlled at the document production unit. In contrast to this, the claimed invention uses the document server to deliver various versions of the document, where the separate versions are released only as appropriate in view of the security server. This approach maintains all control of the document versions at the document server. Thus, the document server only releases versions that are authorized, and not generic versions that are subject to remote release or rights at a destination. Satoh and the other prior art repeatedly asserted throughout this long prosecution all send a document to a destination and then vary the rights in the document once the document is at the destination. Thus, the claimed invention is fundamentally different in its approach to managing document rights and deserving of patent protection.

CONCLUSION

Applicant respectfully posits that the pending claims have been distinguished from the art of record, and that all objections to and rejections of the claims have been overcome. Accordingly, Applicant respectfully requests allowance. Should it be deemed helpful, the panel reviewing this pre-appeal brief is encouraged to contact Applicant's attorney, Michael A. Glenn, at (650) 474-8400.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael A. Glenn', with a long horizontal stroke extending to the right.

Michael A. Glenn

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